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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,821	01/24/2001	Maximilian Angel	51162	2188

7590 02/21/2002

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EXAMINER
WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 02/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/767,821	ANGEL ET AL.	
	Examiner	Art Unit	
	Lauren Q Wells	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 January 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 6-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 6-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *3, 5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claims 1-3 and 6-9 are pending. Claims 4-5 were cancelled, claims 1 and 7 were amended, and claims 8-9 were added by the amendment received January 10, 2002, Paper No. 6.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on February 9, 2000. It is noted, however, that applicant has not filed a certified copy of the German application as required by 35 U.S.C. 119(b).

Specification

The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 6 and 8-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 17 and 20-22 of copending Application No. 09/811542. Although the conflicting claims are not identical, they

are not patentably distinct from each other because both sets of claims are directed toward compositions comprising the same graft copolymers of polyvinyl esters.

Claims 1, 6 and 8-9 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 20, 23, 24-26 of copending Application No. 09/805239. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed toward compositions comprising the same graft copolymers of polyvinyl esters.

Claims 1, 6-7 and 8-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 and 16-20 of copending Application No. 09/787956. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed toward compositions comprising the same graft copolymers of polyvinyl esters and toward the graft copolymers themselves.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 and 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The phrase "free-radical initiator system" in claims 1 (last 2 lines), 2 (lines 1-2) and 7 (last 2 lines) is vague and indefinite. A free radical initiator is defined in the specification, but a free radical initiator system is not. How does a free radical initiator differ from a free radical initiator system?

(ii) The phrase "obtainable" in claim 7 (line 1) is vague and indefinite. Is the graft copolymer produced by the steps in claim 7 or is it not? What does obtainable mean?

(iii) Claim 8 is vague and indefinite. Do coating agents, binders and film-forming excipients all relate to pharmaceutical dosage forms or just film-forming excipients?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 922,459.

GB '459 teach a process for the manufacture of modified polyvinyl alcohols. It is disclosed that it is known to make polyvinyl alcohols by subjecting a graft polymer prepared from one or more vinyl esters and a compound copolymerizable with those vinyl esters, on a polyalkylene glycol under the influence of a free radical forming polymerization initiator. Example 1 discloses a process for preparing a graft polymer comprising heating a solution of vinyl acetate, polyethylene glycol and a free radical initiator (dibenzoyl peroxide), and adding

the residual portion of the solution in a drop-wise manner after the polymerization had set in. The reference discloses its graft copolymer for use in cosmetic products. The reference fails to teach a liquid polyalkylene glycol as a solvent in the free radical initiator system. See pg .1-pg. 3, line 35; pg. 4-pg. 5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach a free radical initiator system comprising a free radical initiator and a liquid polyethylene glycol in the preparation of a polyvinyl ester graft copolymer, using the teachings of GB '459 because a) GB '459 teach a solution of vinyl acetate, polyethylene glycol and free radical initiator (dibenzoyl peroxide) which is heated to induce polymerization to form a graft copolymer; b) GB '459 teach that water-soluble polyethylene glycols having a molecular weight of 10000 up to several millions are preferred, and it is respectfully pointed out that water-soluble polyethylene glycols are liquid polyethylene glycols; hence, since the polyethylene glycol of GB '459 is a liquid polyethylene glycol and since it is in solution with the free radical initiator, it would be within the skill of one in the graft copolymer art to teach polyethylene glycol as a solvent in the free radical initiator system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on T-F (6-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the

organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
February 15, 2002

MINNA MOEZIE, J.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600